

REMARKS

Claims 1, 2, and 14-17 remain in the application. The examiner has withdrawn claims 11-13 and 18-39 from further consideration as being drawn to a non-elected invention or species. The applicant has cancelled claims 3-10.

The office action objects to the drawings under 37 CFR 1.83(a) for ostensibly failing to show the retainers supported on the window aperture as recited in claim 3. In response, the applicant maintains that, the drawings do, in fact, show a retainer supported on a window aperture in Figure 8. Moreover, the applicant maintains that even if the drawings did not show this, there is no requirement for them to do so to support claim 3. This is because claim 3 does not recite retainers supported on a window aperture. Instead, claim 3 recites window retainers that are:

securable at spaced locations around and between an outer peripheral wall of a window frame of a window and an inner peripheral wall of a window aperture in a vehicle wall panel;

configured to connect between the window assembly and the window aperture;

configured to space such a window frame from the inner peripheral surface of such a window aperture; and that are

configured to be supported on one of a window frame and a window aperture.

These are functional descriptions of various aspects of the structure of the window retainers rather than structural descriptions of their relationships to other claimed elements. Accordingly, the applicant maintains that the drawings do, but need not, show the retainers supported on either a window aperture or a window frame.

The office action objects to the drawings under 37 CFR 1.84(p)(5) because they don't include reference numerals 22 and 68. In response, the applicant has included reference numeral 22 in Figures 1-3, 10-13, and 17-26; reference numeral 22a in Figure

4; reference numeral 22b in Figure 5; reference numeral 22c in Figure 6; and reference numeral 22d in Figure 8 as shown in the replacement figures enclosed with this response. The applicant has also included reference numeral 68 in Figures 1-3, 10-12, and 17-26; reference numeral 68a in Figure 4; and reference numeral 68c in Figures 6 and 7 as is also shown in the replacement figures enclosed with this response.

The office action further objects to the drawings because arrows set forth on line 30 of page 15 to line 1 of page 16 are not shown in Figure 14. In response, the applicant has amended Figure 14 to include the arrows as shown in the enclosed replacement Figures accompanying this Response. The addition of these arrows does not constitute the introduction of new matter since these arrows correspond to arrows shown in Figure 15 of the provisional patent application filed 19 June 2001.

In their amended form, the drawings are now in acceptable form.

The office action objects to the abstract of the disclosure for including what the examiner considers to be a number of ambiguous or vague terms. The applicant has amended the abstract of the disclosure to clarify the terminology in question. The applicant has made corresponding amendments to the remainder of the specification. The applicant maintains that the abstract of the disclosure, as amended, is in acceptable form.

The office action objects to the specification because of a number of informalities. The applicant has amended the specification to correct the informalities that the examiner has identified. The applicant maintains that the specification, as amended, is in acceptable form.

The office action rejects claims 1-10 and 14-17 under 35 U.S.C. § 112 ¶ 2 as being indefinite. Specifically, the office action objects to what the examiner considers to be ambiguous or vague terms used in these claims. In response, the applicant has amended these claims to clarify the terminology in question. The applicant has made

corresponding amendments to the specification and maintains that claims 1-10 and 14-17 are now in acceptable form.

The office action rejects claims 1, 2, and 14-17 under 35 U.S.C. § 102(b) as being anticipated by Gebhard. According to the office action, Gebhard discloses a mass transit vehicle window installation assembly that meets all the limitations of these claims.

Regarding claim 1, the applicant maintains that Gebhard neither discloses nor suggests any of the following claim 1 limitations:

- a mass transit vehicle window installation assembly; (Gebhard discloses a window *pane* installation assembly for installing a window in a frame rather than installing a window frame in the wall of a vehicle as claimed)
- a window retainer configured to connect between a window frame of a window and a vehicle wall panel having a window aperture shaped to receive the window (the Gebhard assembly includes a window *pane* retainer that connects between a window *pane* and a window *frame* rather than between a window *frame* and a vehicle wall panel);
- a window retainer configured to be supported on one of a window frame and a window aperture (the Gebhard pane retainer is integrally formed as a single piece with a rim 3 surrounding the edges of a window pane).

For these reasons, the applicant maintains that Gebhard does not anticipate claim 1.

Regarding claim 2, the applicant maintains that Gebhard neither discloses nor suggests that the Gebhard retainer might be additionally configured to retain a window frame in a desired position within a window aperture. Instead, Gebhard teaches a retainer configured to retain a window *pane* in a window *frame*. Accordingly, the applicant maintains that Gebhard doesn't anticipate claim 2.

Regarding claim 14, the applicant maintains that Gebhard neither discloses nor suggests that the Gebhard trim strip ring might be configured to:

- engage respective surfaces of a window frame and a *wall panel* that a *window aperture* is formed in and to cover a gap formed between an outer peripheral surface of the window frame and an inner peripheral surface of the window aperture when the window frame is installed in a window aperture in the wall panel; (again, Gebhard discloses a trim strip ring that is inserted between a window frame and a rim surrounding a window pane rather than between a window frame and a window aperture)
- engage respective *back* surfaces of such a window frame and wall panel (Gebhard discloses a trim strip ring that is inserted between respective *front* surfaces of a window frame and a rim surrounding a window pane).

Accordingly, the applicant maintains that Gebhard doesn't anticipate claim 14.

Regarding claim 15, the applicant maintains that Gebhard neither discloses nor suggests that the stem of the Gebhard trim strip ring might be configured to be inserted in a gap formed between an outer peripheral surface of a window frame and an inner peripheral surface of a window aperture receiving the window frame. Instead, the stem of the Gebhard ring is inserted in a gap formed between a window frame and a rim surrounding a window pane. Accordingly, the applicant maintains that Gebhard doesn't anticipate claim 15.

Regarding claim 16, the applicant maintains that Gebhard neither discloses nor suggests that the Gebhard trim strip ring might include an elongated seal ring configured to prevent moisture and drafts of air from passing through a gap formed between an outer peripheral surface of a window frame and an inner peripheral surface of a window aperture receiving the window frame. Instead, the whole of the Gebhard trim strip ring is, again, inserted in a gap formed between a window frame and a rim surrounding a

window pane – not between a window frame and a window aperture. Accordingly, the applicant maintains that Gebhard doesn't anticipate claim 16.

Regarding claim 17, the applicant maintains that Gebhard neither discloses nor suggests:

- a flange that extends outward from a main portion of a window *frame* in a position disposed against a front surface of a *wall panel* that the window is installed in (instead of extending outward from a window frame, the Gebhard “flange” 19 extends inward from a rim surrounding a window pane);
- a *front* flange positioned to be disposed against a *front* surface of a wall panel that the window is installed in (the Gebhard “flange” 19 is positioned to be disposed against an *interior* surface of a panel 6 of a *window frame* 1 and is disposed adjacent a back surface of the frame rather than against a *front* surface of a vehicle *wall* through which the pane is inserted during installation);
- a front flange that covers a gap between a *window frame* and the inner peripheral wall of a *window aperture* that the window is installed in (again, the Gebhart flange, if it can be said to cover a gap at all, covers a gap between a window frame and a rim surrounding a window pane);
- an elongated rubber seal ring that's connected around and along a back surface of the front flange in a position to seal against the front surface of the wall panel (what the action refers to as being the Gebhart seal ring 11 is installed against an interior surface of a frame panel 6 rather than against either a front or back surface of a vehicle wall).

Accordingly, the applicant maintains that Gebhard doesn't anticipate claim 17.

The office action rejects claims 3-7 and 9 under 35 U.S.C. § 102(b) as being anticipated by Stark. According to the office action, Stark discloses a mass transit vehicle window installation assembly that meets all the limitations of these claims. The applicant has cancelled claims 3-7 and 9.

The office action rejects claims 8 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Stark and further in view of Andre et al. The applicant has cancelled claims 8 and 10.

The office action rejects claims 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Stark and further in view of Ehret et al.

Regarding claim 14, the applicant maintains that the suggested combination doesn't reach the invention of claim 14 because it doesn't include a trim strip ring that approximates the peripheral shape of a window aperture and a window frame configured to be installed in that window aperture as claimed. Instead, the structure that the action refers to as being a trim strip ring 76 extends only along a bottom edge of a window frame within a quick-opening latch arrangement.

Regarding claim 17, the applicant maintains that, again, the suggested combination doesn't reach the invention because the structure that the action refers to as being a front flange 70 isn't part of the Ehret et al. window (sash) frame 100 and doesn't extend outward from a main portion of the frame 100. Instead, as stated in the office action, the front flange 70 is included as part of what the action refers to as being the trim strip ring 76. Also, what the action refers to as being the front flange 70 doesn't cover the gap between the window frame 100 and the inner peripheral wall of a window aperture that the window is installed in as claimed.

In addition, the applicant maintains that the office action doesn't properly support its obviousness determination with regard to claims 14-17. It's well settled that, to support an obviousness determination, you must show why a skilled person, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. To help reduce the likelihood of hindsight-type analyses in these

situations, the courts have held that an examiner, to support an obviousness finding, must show a motivation to combine the references that create the case of nonobviousness. See, e.g., *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998). This motivation to combine may be found either in prior art teachings, the knowledge of persons of ordinary skill in the art, or in the nature of the problem solved. *Id* at 1458. In *In re Rouffet*, the Board relied upon none of these. Rather, the Board relied on the high level of skill in the art as evidence of likely motivation. Similarly, the present office action relies on the recitation of an *advantage* that the inclusion of a trim strip ring and a front flange would realize, i.e., the ability "to provide a better seal between the window pane and the aperture." However, while the level of skill in the art is at least part of the judicially defined inquiry for a suggestion to combine, the ability to identify or think up an advantage is not. If the ability to identify or think up an advantage were alone sufficient to supply a motivation to combine, then, because there is at least some advantage to almost all claimed combinations, the test would be useless to preclude hindsight analyses. The PTO could routinely identify claimed elements in the prior art, observe that there was an advantage in combining them as the applicant has claimed, and simply reject the claims on that basis. The mere existence of an advantage would thereby almost always prevent patentable inventions.

Although motivation need not be found by identifying an explicit teaching or suggestion in all cases, it's not enough to simply identify an advantage. There must at least be some *implicit* teaching or suggestion in the prior art or general knowledge that would have motivated one skilled in the art to combine the references. *In re Oetiker*, 24 USPQ2d 1443, 1446-1447 (Fed. Cir. 1992); *In re Rouffet* at 1458 (motivation may be found in "the nature of the problem to be solved . . ."). To show that there's an implicit suggestion, the Examiner must show that one skilled in the art would know to use a prior art teaching to solve the problem that the applicant sought to solve through the invention in question. *In re Oetiker* at 1446-1447. For this to be the case, the problem that the invention solves must be the same as or at least similar to the problem that the prior art

teaching solves. Here, again, it's not sufficient to merely identify an advantage that the combination would realize.

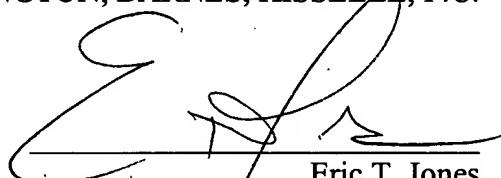
For all the above reasons, and because they depend from an allowable base claim, the applicant maintains that claims 14-17 are patentable over the cited references.

Claims 1, 2 and 14-17 recite patentable subject matter and are allowable. Therefore, the applicant respectfully submits that the application is now in condition for allowance and respectfully solicits such allowance. Please favorably reconsider the outstanding office action.

I authorize the Assistant Commissioner to charge any deficiencies, or credit any overpayment associated with this communication to Deposit Account No. 50-0852. A duplicate copy is enclosed.

Respectfully submitted,

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